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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,498	02/09/2001	Hiroshi Yoshida	1095.1157/JDH	5527

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EXAMINER

BORISOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,498

Applicant(s)

YOSHIDA, HIROSHI

Examiner

Igor Borissov

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2, 6-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 2. The term "can" indicates the potential capability, not an actual method step. Also, it is not clear to what the registration terminal is connected.

Claims 2 and 6. The term "a usage point" is confusing.

Claims 7 and 8. It is not clear what method steps does the term "a user interface control process" actually contemplate.

Claim 10. The terms "transit control program" and "transit control process" are confusing.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 9 is rejected under 35 U.S.C. 101 because the claimed method for controlling a server does not recite a limitation in the technological arts. The independently claimed steps of: "acquiring circuit information" and "determining noise countermeasure information" are abstract ideas which can be performed mentally without interaction of a physical structure. The method step: "acquiring circuit information" may be understood as merely receiving a booklet over a mail. However, the

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claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. App. & Inter. 2001)).

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, this claim is not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that this claim recites statutorily permitted subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson et al. (US 6,594,799) in view of Van Huben et al. (5,950,201).

Robertson et al. (hereinafter Robertson) teaches a method and system for facilitating electronic circuit and chip design using remotely located resources, comprising:

Claim 1. A portal site including an application server having databases containing a user database and a catalog database (Figs. 1 and 2; column 8, lines 36-40); said portal site stores electronic components and virtual circuit blocks information (column 5, lines 1-10); said information (tools and services) are provided by suppliers (experts) connected to the portal site (column 5, lines 11-12); wherein all elements are interconnected via the Internet. Said information (tools and services) are presented in the format identifying information (tools and services) available, thereby suggesting registration of said information (column 5, lines 12-17). Said portal site includes means for purchasing said information (column 5, lines 17-19; column 13, lines 46-63).

Robertson does not specifically teach that said electronic components and virtual circuit blocks information includes noise countermeasure information.

Van Huben et al. teach an automatic design control method and system for computerized design of integrated circuits, including a library of tools for modeling said circuits, wherein noise analysis tools are employed (column 17, lines 58-64).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Robertson to include that said electronic components and virtual circuit blocks information includes noise analyses tools, because it would allow to design said electronic circuit cheaper and faster.

Claim 2. Said method and system, wherein said means for purchasing comprises means for collecting data on usage of said information (column 9, lines 16-21).

Claim 3. Said method and system, comprising at least one of: an information registration requesting unit (column 5, lines 12-17), said means for collecting data on usage of said information (column 9, lines 16-21), and an information usage processing unit comprising circuit information transmitting means for transmitting circuit information to said server (column 5, lines 1-15) and identifier transmitting means for transmitting an identifier of the client apparatus (column 13, lines 24-26, 35-40).

Claim 4. See claim 1.

Claim 5. See claim 1.

Claim 6. See claim 2.

Claim 7. Said method and system, comprising means for collecting data on usage of said information (column 9, lines 16-21), and an information usage processing unit comprising circuit information transmitting means for transmitting circuit information to said server (column 5, lines 1-15) and identifier transmitting means for transmitting an identifier of the client when said server is accessed (column 13, lines 24-26, 35-40).

Claim 8. Said method and system, comprising means for presenting said electronic components and virtual circuit blocks information in the format identifying said information available, thereby suggesting registration of said information (column 5, lines 12-17).

Claim 9. Said method and system, comprising: means for receiving request for said electronic components and virtual circuit blocks information transmitted from said client, means for presenting said electronic components and virtual circuit blocks information and means for transmitting the determined said electronic components and virtual circuit blocks information to said client (column 5, lines 1-17).

Claim 10. See claim 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JB

[Signature]

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600